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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,663	03/30/2000	Bjorn Markus Jakobsson	Jakobsson 22-2	8288
46304	7590	09/29/2004	EXAMINER	
RYAN, MASON & LEWIS, LLP 90 FOREST AVENUE LOCUST VALLEY, NY 11560			KARMIS, STEFANOS	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/538,663

Applicant(s)

JAKOBSSON ET AL. ✓

Examiner

Stefano Karmis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The following communication is in response to Applicant's amendment filed on 28 June 2004.

Status of Claims

2. Claims 1-16 are left as originally presented. Therefore claims 1-16 are under prosecution in this application.

Summary of this Office Action

3. The declaration filed on 28 June 2004 under 37 CFR 1.131 is sufficient to overcome the Drummond reference. A new grounds for rejection has been established, and is detailed below. Therefore claims 1-16 are rejected and Applicant's request for allowance is respectfully denied.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Cobb U.S. Patent 6,199,102.

Regarding independent claim 1, Cobb discloses a method for preventing receipt by receivers of unwanted electronic mail messages sent by senders in a communication system comprising: determining whether a particular sender is a registered sender of email to the particular receiver, wherein the particular sender becomes a registered sender by satisfying a requirement which will allow the particular sender to become a registered sender of email to the particular receiver (column 5, lines 5-39); weeding out at a gateway of the communication system all email directed to a particular receiver that originates from senders that are determined not to be registered senders to the particular receiver and passing to the particular receiver all email directed to the particular receiver and that originates from senders determined to be registered senders of email to the particular receiver (column 19, lines 1-24 and Figures 7a and 7b).

Claim 2, setting up by the particular sender a cookie which indicates to the particular receiver whether the particular sender has satisfied the requirement to allow the particular sender to become a registered sender to the particular receiver; setting up an address related to an address associated with the particular receiver which will inform the particular sender that the

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particular receiver desires that the particular sender be able to send email to the particular receiver; and setting up by the particular receiver a key which is forwarded to the particular sender by the particular receiver to inform the particular sender that the particular sender is authorized to send email to the particular receiver and is not a registered sender and for use by the particular sender whenever the particular sender wishes to send email to the particular receiver (column 7, line 54 thru column 8, lines 34 and column 8, line 48 thru column 9, line 32).

Claim 3, generating a pseudorandom function with a keyed hash function using an input number comprising a unique serial number for use in generating an identifier for email between the particular send to the particular receiver (column 9, lines 11-54).

Claim 4, setting up an encrypted address comprises sending email from the particular receiver to the particular sender using public key encryption (column 14, lines 56 thru column 15, line 2).

Claim 5, sending to the particular user by the particular receiver, an encrypted key wherein the encrypted key is a member of a set of encrypted keys (column 9, lines 11-55).

Claim 6, storing the encrypted key by the particular sender in a table of encrypted keys for use by the particular sender whenever the particular sender desires to send email to the particular receiver (column 9, lines 42-55).

Claim 7, examining a message authentication code (MAC) by the particular receiver and determining whether the examined MAC is a valid MAC; and rejecting the email sent by the particular send if the MAC is determined not to be a valid MAC (column 19, lines 1-41 and Figures 7a and 7b).

Claim 8, comparing the MAC against a value determined in said sender determining step and, if the value and the determined MAC are the same, accepting by the particular receiver the email from the sender (column 19, lines 1-41 and Figures 7a and 7b).

Claim 9, comparing the MAC to an available header in an address of the particular receiver, in the received email message, whereby the MAC is not a valid MAC if the MAC and the header are not identical (column 19, lines 1-41 and Figures 7a and 7b).

Regarding independent claim 10, Cobb discloses a server method for preventing receipt by receivers of unwanted electronic mail messages sent by senders in a communication system comprising: a determining module for determining whether a particular sender is a registered sender of email to the particular receiver, wherein the particular sender becomes a registered sender by satisfying a requirement which will allow the particular sender to become a registered sender of email to the particular receiver (column 5, lines 5-39); a weeding out module for weeding out at a gateway of the communication system all email directed to a particular receiver that originates from senders that are determined not to be registered senders to the particular receiver and a passing module for passing to the particular receiver all email directed to the

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particular receiver and that originates from senders determined to be registered senders of email to the particular receiver (column 19, lines 1-24 and Figures 7a and 7b).

Claim 11, generating a pseudorandom function with a keyed hash function using an input number comprising a unique serial number for use in generating an identifier for email between the particular send to the particular receiver (column 9, lines 11-54).

Claim 12, setting up an encrypted address comprises sending email from the particular receiver to the particular sender using public key encryption (column 14, lines 56 thru column 15, line 2).

Claim 13, sending to the particular user by the particular receiver, an encrypted key wherein the encrypted key is a member of a set of encrypted keys (column 9, lines 11-55).

Claim 14, examining a message authentication code (MAC) by the particular receiver and determining whether the examined MAC is a valid MAC; and rejecting the email sent by the particular send if the MAC is determined not to be a valid MAC (column 19, lines 1-41 and Figures 7a and 7b).

Claim 15, comparing the MAC against a value determined in said sender determining step and, if the value and the determined MAC are the same, accepting by the particular receiver the email from the sender (column 19, lines 1-41 and Figures 7a and 7b).

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Claim 16, comparing the MAC to an available header in an address of the particular receiver, in the received email message, whereby the MAC is not a valid MAC if the MAC and the header are not identical (column 19, lines 1-41 and Figures 7a and 7b).

Response to Arguments

6. Applicant's arguments with respect to claim 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

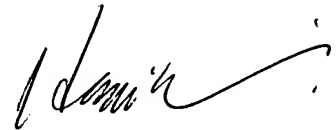
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted
Stefano Karmis
20 September 2004



HANI M. KAZIMI
PRIMARY EXAMINER